

Serial #: 10/056,790  
Reference #: EX02-004C

### REMARKS

There are no further amendments to the claims in this case. Appendix A is a reiteration of the claim amendments presented in the amendment of 2/25/2004, which were not entered into the case.

It is believed that proper procedure has not been followed by the examiner for the prosecution of this application for the reasons set forth below. Applicants are trying to promote a fair prosecution of their application, and have followed all the proper procedures in this case. Accordingly, applicants request the examiner reconsider the non-entry of the 2/25/04 amendment. Accompanying this response is also a petition to enter the amendment of 2/25/2004 under 37 C.F.R. § 1.181.

In the telephone conversation of February 19, 2004 between the undersigned and the examiner, the undersigned brought the examiner's new arguments in the office action of 01/09/04 to his attention. The examiner, after consulting with his supervisor, agreed that the final rejection was premature, and also agreed to remove the finality of the office action. Thereafter, a full amendment after final, highlighting the conversation, and including examiner's suggested amendments that would come under favorable view was drafted and filed on 2/25/04.

The supplemental final rejection of 3/22/2004 comes as a surprise, especially since a full and complete response by the applicants, removing any issues for rejection, was presented but not entered. It is noted that the applicants did not request a supplemental action, nor did they request the clock for the office action to be reset (MPEP 710.06), nor did the action cross the amendment (MPEP 714.05). Rather, applicants entered a full amendment in response to the action of 01/09/04. It is believed that the examiner did not follow proper procedure by refusal to enter the amendment, while issuing yet another final rejection.

On paragraph 2 of the office action, the examiner states that the after-final amendments filed 2/24/04 were not entered because they fail to comply with the requirements of form expressly set forth in a previous office action. Applicants respectfully disagree.

The first office action of 8/1/2003 provided a 35 USC 112, 2<sup>nd</sup> paragraph rejection for the use of the term RRP (paragraphs 6 and 7), and a 35 USC 112, 1<sup>st</sup> paragraph

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enablement rejection because according to the examiner, while RRP 1-2, 4-8 and mouse RRP were enabled, all RRP's were not enabled (paragraph 8). The response of 10/27/2003 provided argument for the indefiniteness rejection, but noted that an examiner's amendment would be acceptable to applicants should the rejection be maintained (pages 6 and 7), and also amended the claims to satisfy the enablement requirement of 35 USC 112, 1<sup>st</sup> paragraph by naming the RRP's (pages 5 and 7).

The office action of 1/9/04 rejected the claims again for indefiniteness (paragraph 4), and introduced a 35 USC 112, 1<sup>st</sup> paragraph written description rejection (paragraph 5), stating "The guidelines for the examination of patent applications under the 35 U.S.C. ¶ 1 "Written Description" requirement make clear that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species ....(Federal Register, Vol 66, No.4, pages 1099-1111, Friday January 5, 2001, see especially page 1006 3<sup>rd</sup> column". The after final response of 2/25/2004 amended the claims to spell out RRP and also identified all sequences by their SEQ ID NOs, thus expressly following examiner's suggestion and requirement of form (pages 2-4). Thus, the amendment should have been entered.

In light of the withdrawal of the 1/9/04 rejection, the current office action reiterates the indefiniteness rejection (paragraph 5) and provides a 35 USC 112, 1<sup>st</sup> paragraph written description requirement rejection (paragraph 6). The indefiniteness rejection was already addressed in the 10/27/03 and 2/25/04 amendments as stated above, and should have been entered. The written description rejection also spells out the SEQ ID NOs for which the written description requirement is satisfied (paragraph 6, lines 6-8). Again, the amendment of 2/25/04 already addressed this requirement (pages 2-4), and should have been entered.

Thus, it is not understood exactly what requirement of form the applicants have not yet satisfied that resulted in the non-entry of the 2/25/04 amendment. Accordingly, applicants request for the entry of the 2/25/04 amendment.

#### **Claim Rejections – 35 USC §112, 2<sup>nd</sup> Paragraph**

On paragraph 5 of the office action, claims 8-12 were rejected under 35 USC 112, 2<sup>nd</sup> paragraph as being indefinite. Amended claim 8 of 2/25/04, provided as Appendix A

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below, clearly defines the term RRP, and also defines each RRP by a SEQ ID NO, and thus, overcomes the rejection.

As such, claims 8-12 meet the requirements of 35 USC 112, 2<sup>nd</sup> paragraph.

#### **Claim Rejections – 35 USC §112, 1<sup>st</sup> Paragraph**

On paragraph 6 of the office action, claims 8-12 were rejected under 35 USC 112, first paragraph, for lack of proper written description for all RRP in literature. Amended claim 8 of 2/25/04 amendment, also attached as Appendix A below, provides a clear definition of the term RRP, and further identifies each RRP using a SEQ ID NO, thus overcoming the rejection.


As such, claims 8-12 meet the written description requirement of 35 USC 112, 1<sup>st</sup> paragraph.

#### **CONCLUSION**

It is believed that all the objections and rejections raised by the Examiner have been addressed and that the application is in condition for allowance. The Examiner is encouraged to telephone the undersigned with any questions or comments regarding this response.

Respectfully submitted,

Dated: May 3, 2004

  
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**Appendix A- Claims as presented in the 02/25/2004 amendment**

1-7. (Canceled)

8. (Currently amended) A method of screening for agents that modulate the interaction of an Rhomboid Related Protein (RRP) polypeptide with an RRP binding target, comprising:

- a) expressing a recombinant RRP polypeptide,
- b) incubating the recombinant RRP polypeptide with an RRP binding target and a candidate RRP modulating agent and
- c) determining whether said candidate RRP modulating agent modulates the binding of RRP polypeptide with the RRP binding target,

wherein RRP is selected from the group consisting of SEQ ID NO:2 (RRP1), SEQ ID NO:4 (RRP2), SEQ ID NO:6 (RRP3), SEQ ID NO:8 (RRP4), SEQ ID NO:10 (RRP5), SEQ ID NO:12 (RRP6), SEQ ID NO:14 (RRP7), SEQ ID NO:16 (RRP8), and SEQ ID NO:46 (mRRP1).

9. (Original claim) The method according to claim 8 wherein said binding target is selected from the group consisting of TGF $\alpha$ , EGF, and amphiregulin.

10. (Original claim) The method according to claim 8 wherein said binding target is TGF $\alpha$ .

11. (Original claim) The method according to claim 8 wherein said candidate RRP modulating agent is an antibody.

12. (Original claim) The method according to claim 8 wherein said candidate RRP modulating agent is a small organic molecule.

13-51. (Canceled).